REMARKS

Claims 1-24, 26, and 30 are currently pending in the patent application. The Examiner has rejected Claims 1-2, 12-13, 16-17 and 19 under 35 USC 102(e) as anticipated by Yeo; Claims 24, and 26-30 under 35 USC 102(e) as anticipated by Yeo; Claims 4-8, 10, 14-15, 18, and 20-23 under 35 USC § 103 as being unpatentable over Yeo in view of Inoue; Claim 11 under 35 USC 35 as unpatentable over the teachings of Yeo in view of Mankovitz; and Claim 9 under 35 USC 103 as being unpatentable over the teachings of Yeo in view of Inoue and further in view of Dureau. For the reasons set forth below, Applicants respectfully assert that all of the pending claims are patentable over the cited prior art.

Applicants first note that there is an error in the Office Action. The Examiner has rejected Claims 24 and 26-30 as anticipated by the Yeo patent citing passages from Columns 18-22. However, the Yeo patent only has 14 columns. Further the rejections of Claims 24 and 26-30 refer to the Inoue patent; although the claims have not been expressly rejected based on the Inoue patent. Applicants will attempt to address the rejections. However, Applicants respectfully

contend that any Office Action generated in response to this Amendment should be in the form of a ***non-final Office Action,*** thereby affording Applicants an opportunity to respond to the actual bases for rejection of the claims.

The present invention teaches a system, method, apparatus, and broadcast stream wherein secondary content which relates to the primary content of a broadcast stream is scheduled for cyclic delivery with the primary content. The delivery of secondary content is cyclic, as detailed on page 8 of the present Specification, which means that it is sent multiple times in the course of delivery and display of the primary content. The secondary content is first delivered as part of the initial broadcast, preferably before the primary content to which it pertains. Thereafter, for those viewers who might tune in late, the secondary content is cyclically broadcast or, alternatively, is rebroadcast to multiple requesting viewers or is narrowcast to individual requesting viewers.

The Yeo patent is directed to a method and apparatus for displaying a visual program summary comprised of video frames from one or more video programs available for viewing. Yeo extracts frames from each available video stream, discards duplicate frames, and displays a plurality

of the frames as a "snapshot" of each video program. The viewer may then peruse the snapshots and select a video stream for viewing.

Applicants respectfully assert that the Yeo patent does not teach or suggest the invention as claimed in Claims 1-2, 12-13, 16-17 and 19. Applicants first note that the Examiner has concluded, in paragraph 2 at the bottom of page 2 of the Office Action, that the digital frames of the video program summary anticipate the claimed "secondary content which relates to the main primary content". Applicants disagree. What is expressly taught in Col. 2, lines 37-40 of Yeo, is a "visual program display comprising a plurality of video frames from the captured video." Yeo is not displaying secondary content, but is displaying selected frames of the primary content. Display of portions of the primary content does not anticipate or obviate the method and means for obtaining secondary content which relates to the primary content, creating a scheduled for delivery of the secondary content in a predetermined relation to the non-cyclic broadcasting of the primary content, or cyclically delivering the secondary content based on the schedule.

In addition to concluding that the video program summary anticipates the secondary content of the present invention, the Examiner has cited the teachings from Col. 9, lines 45-63 against the secondary content. What Yeo teaches in Col. 9 is that the computer system may access the TV program schedule, program title, and/or rating information, "that is delivered along with the MPEG 2 encoded video information" (Col. 9, lines 56-58) or which "may be added to the visual program summary display" (Col. 9, lines 61-63). Clearly, Yeo is not creating a schedule for delivery of secondary content in a predetermined relationship to the non-cyclic broadcasting of the primary content and then cyclically delivering the secondary content based on the schedule. Rather, Yeo is displaying the TV program schedule simultaneously with the non-cyclic, static display of a frame of the primary content. The simultaneous static display of video frames with a TV program schedule, title, and/or rating information is not the same as or suggestive of creating a schedule for delivery of secondary content data in a predetermined relationship to the non-cyclic broadcasting of the primary content and cyclically delivering the secondary content based on the schedule. Accordingly, Applicants believe that the Yeo patent does not

anticipate the language of independent Claims 1 and 19, or of the claims which depend therefrom and add further limitations thereto.

With regard to Claim 2, the Examiner cites the same teachings found at Col. 9, lines 45-63. Applicants content, however, that the cited passage makes no mention of delivery of secondary content prior to delivery of primary content, let alone in conjunction with at least one successive delivery of the secondary content. Yeo only teaches simultaneous static display of the information.

With regard to Claim 12, the Examiner concludes that the teachings found in the passage from Col. 9, lines 45-63 as well as in the passage from Col. 4, lines 15-26 anticipate primary content being delivered in an analog broadcast signal and secondary content being delivered in the vertical blanking interval (VBI). Applicants have reviewed the cited teachings and find no mention of primary and secondary content and no mention of the VBI. Clearly, the cited passages do not anticipate the claim language.

Similarly with regard to Claim 13, the Examiner cites the passage from Col. 9, lines 45-63. However, that passage does not teach or suggest a digital television broadcast stream as a transport medium for primary content and having

an additional data stream within the digital television broadcast stream for secondary data. Yeo does not teach multiple digital streams and does not teach secondary data within a stream.

With regard to Claims 16 and 17, the Examiner has rejected the claim language as anticipated by Yeo teachings found at Col. 5, lines 37-52 and Col. 9, line 45-Col. 10, line 6. Applicants have reviewed the cited passages and find no teaching or suggestion of control information with secondary content. The cited passages describe the control program which extracts video frames for the video program summary. However, those passages make no mention of control information being communicated with secondary content.

Anticipation under 35 USC 102 is established only when a single prior art reference discloses each and every element of a claimed invention. See: In re Schreiber, 128 F. 3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997); In re Paulsen, 30 F. 3d 1475, 1478-1479, 31 USPQ2d 1671, 1673 (Fed. Cir. 1994); In re Spada, 911 F. 2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990) and RCA Corp. v. Applied Digital Data Sys., Inc., 730 F. 2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984). Since the Yeo patent does not teach or suggest the steps or means for creating a schedule for

delivery of secondary data content in a predetermined relation to the non-cyclic delivery of primary content and does not teach or suggest the steps or means for cyclic delivery of secondary content based on the schedule, it cannot be concluded the Yeo anticipates the invention as claimed.

With regard to Claims 24 and 26-30, Applicants again note that the Examiner has rejected the claims as anticipated by Yeo, yet cites passages from Columns which are not found in the Yeo patent. Applicants further note that the Examiner cites Inoue in the paragraphs found after the rejection. Applicants will address the Inoue patent, but reiterate the request that the responsive Office Action should be non-final.

The Inoue patent is directed to a system and method for providing data between different devices over a single data bus. Audio and video data from a television server, music data from a tune server, additional audio information from an additional audio information server, and GUI data from a GUI server can all be multiplexed at a terrestrial station and then sent via a charging server or satellite system to a single user location along the one data bus. What Inoue teaches is that the terrestrial station time multiplexes the

packets for transmission (see: Col. 17, lines 12-21). At the receiving end of the Inoue system, the received content is displayed via a GUI for user selection and then recorded at the MD Recorder/Player (Col. 14, lines 36-52).

With regard to Claims 24 and 26, Applicants contend that, while Inoue does provide visual display information as well as audio information, Inoue does not teach or suggest means for extracting control information and for handling secondary content based on extracted control information. Therefore, it cannot be maintained that Inoue anticipates the language of Claim 24 or of Claim 26 which depends therefrom and adds further limitations thereto.

With regard to Claims 27-30, Applicants have canceled Claims 27-29 and have amended the language of Claim 30 to include all of the limitations of the claims from which it previously depended. Applicants believe that neither the Yeo nor the Inoue patent anticipates the invention as claimed, since neither teaches or suggests a broadcast stream comprising first ephemeral primary content, at least two iterations of cyclic secondary content which relates to the primary content and is interspersed with the first ephemeral primary content, and control information related to said secondary content, wherein the control information

comprises at least one of a unique identifier for said secondary content, an identification of said primary content to which the secondary content pertains, scheduling information regarding future broadcasts of the secondary content, and timing information regarding relating said secondary content to said primary content. Applicants respectfully assert that the teachings of the Inoue patent do not anticipate the claim language and do not obviate the claim language alone or in combination with the additionally-cited references. For a patent to anticipate another invention under 35 USC § 102(b), the patent must clearly teach each and every claimed feature of the anticipated invention. Since the Inoue patent clearly does not teach a broadcast stream having the primary, secondary, and control information as claimed, it cannot be maintained that the Inoue patent anticipates each and every claim feature.

The remaining rejections, of Claims 4-8, 9, 10, 11, 14-15, 18 and 20-23 all rely on the Yeo patent as the primary reference. Applicants rely on the arguments presented above with respect to the teachings of the Yeo patent. Applicants reiterate that the Yeo patent does not teach or suggest means or steps for creating a schedule for

delivery of secondary content with the non-cyclic delivery of primary content and does not teach or suggest means or steps for the cyclic delivery of secondary content based on that schedule. Further, it is respectfully argued that none of the additionally cited art teaches or suggests those features which are missing from the Yeo patent. The Mankovitz patent shows icon display. However, the addition of Mankowitz to Yeo does not teach or suggest each and every claim feature of Claim 11, including all of the features of Claim 1 from which it depends. The Dureau patent teaches routing based on a number of requests but does not teach or suggest retransmission of secondary content based on a number of requests, let alone that feature of Claim 9 in addition to the features of Claims 8, 6, 5 and 1 from which Claim 9 depends.

For a determination of obviousness, the prior art must teach or suggest all of the claim limitations. "All words in a claim must be considered in judging the patentability of that claim against the prior art" (In re Wilson, 424 F. 2d 1382, 1385, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970). If the cited references fail to teach each and every one of the claim limitations, a *prima facie* case of obviousness has not been established by the Examiner.

Based on the foregoing amendments and remarks, Applicants request entry of the amendments, reconsideration of the rejections, withdrawal of the rejections, and issuance of the claims.

Respectfully submitted,

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